

REMARKS

I. Status of the Subject Application

At the outset, Applicant wishes to express appreciation to Examiner Baxter for determining that the subject application contains patentable subject matter.

Claims 1-49 are pending in the subject application. Claims 1-6, 16-21, 28-32, and 37 are allowed. Claims 14, 15, 23-27, 35, and 36 have been objected to. Claims 7-13, 22, 33, 34, and 38-49 stand rejected.

II. The Rejections Under 35 U.S.C. § 103(a)

A. Claims 7-11, 39 and 40

Claims 7-11, 39 and 40 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,846,018 to Frobosilo et al. ("Frobosilo et al.") in view of U.S. Patent No. 6,009,681 to Kozloff ("Kozloff"). Responsive to these rejections, Applicant respectfully submits the following:

i. Claims 7-11

Without acquiescing to any of the specific assertions made in the Official Action concerning Frobosilo et al. and/or Kozloff and expressly reserving the right to challenge such assertions in the future, Applicant has amended claim 7 to clarify that at least one stiffener region is embossed into the second connector plate. The Official Action asserts that in Frobosilo et al., "[o]ne or more rows of fastener receiving holes (28a, b, n) extend through the second connector plate and are disposed within a stiffener region therein for non-movably fastening the second connector plate to another one of the building components." However, as can clearly be seen in Figure 1 of Frobosilo et al., the holes (28a, 28b and 28n) extend through the flat portion of the plate. None of those holes are provided through a stiffener region that is embossed into the plate.

Likewise, as can be seen in Figures 5 and 6 of Kozloff, the holes 50 are not provided in a stiffener region that is embossed into the plate. Accordingly, even if one were to combine the teachings of Kozloff with Frobosilo et al. (which Applicant submits that there is no motivation to do so) the resulting combination would at least lack one or more rows of fastener-receiving holes extending through the second connector plate and being disposed within at least one of the embossed stiffener regions. Thus, claim 7 and claims 8-11, which depend directly or indirectly from claim 7, are seen to be patentable over the asserted combination of Frobosilo et al. and Kozloff.

ii. Claims 39 and 40

Claim 39 recites:

a plurality of first stiffener channels formed in said right angled juncture,
each said first stiffener channel having a first geometric configuration;

a plurality of second stiffener channels in said second connector plate,
each said second stiffener channel corresponding to one of said first stiffener
channels and having a second geometric configuration that differs from said first
geometric configuration;

Applicant respectfully submits that Frobosilo et al. discloses various types of clips that employ “deformed stiffeners” 30, 32 (Figure 1), 220, 222 (Figures 7 and 8) and 320, 322 (Figures 9-11). Kozloff discloses the use of “dimple portions 78” in the junction of the base portion 30 and the inside upright portion 34. The Official Action asserts that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the angled juncture of Frobosilo to have incorporated the plurality of stiffeners along the stiffener channels for the purpose of improving the structural integrity of the bracket by preventing bending or other deformation to the bracket”.

Responsive to this assertion, Applicant does not dispute that providing stiffeners in the right angled juncture would strengthen the part. However, claim 39 recites that each second stiffener **corresponds to** one of the first stiffener channels. The Official Action fails to point to

any teaching that would have led the skilled artisan to include the dimples of Kozloff in the clips of Frobosilo et al. such that those dimples **correspond to** one of the deformed stiffeners of Frobosilo et al. Accordingly, Applicant respectfully submits that a *prima facie* case of obviousness has not been established with respect to claim 39. This argument applies with equal force to claim 40. Thus, without acquiescing to any other specific assertions made in the Official Action concerning Frobosilo et al. and/or Kozloff and expressly reserving the right to challenge such assertions in the future, Applicant traverses the rejections of claim 39 and 40 for the above-mentioned reasons.

B. Claims 12 and 13

Claims 12 and 13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,664,392 to Mucha ("Mucha") in view of U.S. Patent No. 5,454,203 to Turner ("Turner"). In the Official Action, the Examiner acknowledges that "Mucha fails to teach a plurality of stiffener channels and a score line on the second connector plate." The Official Action asserts, however, that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the second plate to have incorporated the score line for the purpose of allowing easy penetration of nails (col 3, line 24+)." Applicant respectfully disagrees for the following reasons.

Mucha discloses the use of pairs of holes that are adapted to receive fasteners therethrough for attaching the clip to a member. When a hole is provided completely through the part, there is no need for anything that will "ease the penetration of nails" as asserted in the Official Action. Moreover, Mucha teaches that the pairs of holes are provided in desired locations in the clip. Mucha provides:

Second plate 14 includes a plurality of holes 24 therein which are positioned in pairs above and below central stiffener 16 as shown.

Column 3, lines 23-25. Mucha further provides that:

The pairs of holes 24 are $\frac{3}{4}$ inch apart and are spaced from the free and common edges by $\frac{1}{2}$ inch...

Column 3, lines 63-65. Thus, as can be appreciated from the above passages, Mucha requires **pairs of holes spaced at a desired distance from each other** and located **above and below** the central stiffener 16.

The Official Action fails to point to teaching that would lead the skilled artisan to replace the pairs of holes 24 of Mucha with a single score line that would ensure that the installer employed **pairs of fasteners above and below** the central stiffener region and that such fasteners would be spaced relative to each other at **a desired spacing orientation**. Applicant submits that there is no teaching to combine Turner with Mucha. Accordingly, Applicant respectfully submits that a *prima facie* case of obviousness has not been established with respect to claims 12 and 13.

C. Claim 41

Claim 41 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Frobosilo et al. in view of Kozloff and further in view of Turner. Responsive to this rejection, Applicant submits that claim 41 depends from claim 40 which, as was discussed above, is seen to be patentable over the asserted combination of Frobosilo et al. in view of Kozloff. The addition of Turner to this combination fails to provide the teachings and motivation that were deemed to be lacking in Frobosilo et al. and Kozloff. Accordingly, Applicant respectfully traverses this rejection.

D. Claims 22 and 42-45

These claims have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,920,713 to Borresen et al. ("Borresen et al.") in view of Turner. The Official Action recognizes that Borresen et al. fails to teach a score line in the first connector plate. The Official Action asserts, however, that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the second plate to have incorporated the score line for the purpose of allowing easy penetration of nails (col. 3, line 24+)"

Applicant respectfully disagrees for several reasons. First, the Borresen et al. bracket is provided with holes for receiving fasteners such as nails or screws therethrough. By using a score line as taught in Turner, the fasteners (nails or screws) must be **forced through** the metal

and into the part to which the bracket is to be attached. With the Borresen et al. bracket, to the contrary, the installer simply inserts the nails or screws through the holes that are provided and then installs them into the underlying member. The installer does not have to force (hammer, screw, etc.) the fastener through the bracket. Thus, Applicant submits that there is a clear disincentive to replace the holes in the Borresen et al. bracket with a score line as disclosed in Turner. For this reason alone, there would be no motivation to combine Borresen et al. with Turner.

In addition to the above-mentioned reason, all of the holes in the first and second legs (20, 21) of the Borresen et al. bracket except for hole 31 are formed such that the fastener heads are essentially countersunk. Notably, Borresen et al. provides:

The second leg 21 has four holes 28 and one oval orifice 29 for mounting screws or nails. Holes 28 and orifice 29 are surrounded by **depressions for receiving the head of the screws or nails**. The first leg has two similar mounting holes 30 and a hole 31 with a larger diameter for allowing admission to a mounting hole 32 surrounded by a depression in member 24.

Column 3, lines 37-43 (emphasis added). Figure 1 of Borresen et al. illustrates that the heads of the nails or screws 19 are essentially countersunk such that they do not interfere with the flashing 14. Thus, if one were to replace the holes 30 through leg 20 with a score line, when the fastener was installed, its head would not be countersunk – without the need for the installer to preform the hole so that the fastener head would be countersunk. This activity would lengthen the amount of installation time and require the use of an additional tool (a drill) which are clear disincentives to making the asserted modification.

With respect to hole 31 which does not have a depressed portion, Borresen et al. provides:

The first leg has two similar mounting holes 30 and a hole 31 with a larger diameter for allowing admission to a mounting hole 32 surrounded by a depression in member 24.

Column 3, lines 40-43. Thus, the hole 31 lacks the depressions that the other holes 28, 30 have. However, hole 31 must be precisely located such that during installation, it essentially registers

with another hole 32 to enable the fastener to be inserted through hole 31 and into the adjacent hole 32. Thus, hole 31 must be precisely located to enable it to register with one of the holes 32 during installation. Accordingly, if one were to use a score line to locate hole 31, the installer could not be sure that simply by installing the fastener on the score line that it would register with the other underlying hole. Moreover, a fastener installed in that manner would serve to fasten the leg 20 to the member 24 in a manner that differs from the manner in which Borresen et al. provides. Thus, for all of the above-mentioned reasons, there is no motivation to replace the predrilled holes in the Borresen et al. bracket with a score line. Accordingly, Applicant submits that a *prima facie* case of obviousness has not been established with respect to claims 22 and 42-45.

E. Claims 33, 34 and 38

Claims 33, 34 and 38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,691,491 to Lilley in view of Turner. In the present Amendment, Applicant has amended claim 33 to clarify that the first and second connector plates form an L-shaped clip with a juncture therebetween. Claim 33 was further amended to clarify that at least one elongated slot extends along an axis that is substantially perpendicular to the juncture. The bracket of Lilley is not L-shaped; it is U-shaped. In addition, the slots in the Lilley bracket do not lie along an axis that is substantially perpendicular to either of the junctures between the bottom plate and the side plates of the Lilley bracket. Turner also at least lacks the recited slot arrangement. Accordingly, even if one were to combine Turner with Lilley (which Applicant submits that there is no motivation to do so) the resulting combination would at least lack these features of amended claim 33. Because claim 34 depends from amended claim 33, it, too, is seen to be patentable over this asserted combination of references.

With respect to the rejection of claim 38, Applicant submits that claim 38 recites that the slide clip comprises, among other things, at least one elongated slot in at least one recessed stiffener region. Neither Lilley nor Turner disclose a slot that is within a recessed stiffener region. Accordingly, a *prima facie* case of obviousness has not been established with respect to

this claim.

F. Claims 46-49

Claims 46-49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,018,923 to Wendt in view of Turner. The Official Action provides that “Wendt fails to teach the use of a dimple or score line”. The Official Action further asserts that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified a second plate to have incorporated the score line for the purpose of allowing easy penetration of nails (col 3, line 24+).”

Applicant respectfully disagrees for the following reasons. First, the Wendt bracket is provided with **holes** for receiving fasteners such as nails or screws therethrough. By using a score line as taught in Turner, the fasteners (screws) must be forced through the metal and into the part to which the bracket is to be attached. With the Wendt bracket, to the contrary, the installer simply inserts the screws through the holes that are provided and then installs them into the underlying member. The installer does not have to force (hammer, screw, etc.) the fastener through the bracket. Thus, Applicant submits that this is a clear disincentive to replace the holes in the Wendt bracket with a score line as disclosed in Turner. For this reason alone, there would be no motivation to combine Wendt with Turner.

In addition to the forgoing reason, Applicant submits that Wendt discloses the use of “an embossed crease or a crease created by a ‘V’ punch” to form a **weakened zone** in the bracket whereby the bracket may be bent. See, column 2, lines 24-27 and column 52-58. An additional score line in the bracket would introduce confusion in the installation process and create the undesirable possibility that the installer may attempt to improperly insert the fasteners through the weekend areas or attempt to improperly bend the connector along the score line. Accordingly, for this reason in addition to the above-mentioned reason, Applicant respectfully submits that there is no teaching to combine Wendt and Turner and, in fact, Wendt teaches away from Turner. Thus, a *prima facie* case of obviousness has not been established with respect to claims 46-49.

III. The Objected To Claims

Claims 14, 15, 23-27, 35 and 36 have been objected to as being dependent upon a rejected base claim. However, the Official Action provides that these claims would be allowable if rewritten in independent form to include all of the limitations of their base claims and any intervening claims.

With respect to claims 14 and 15, those claims depend from claim 12. In the present Amendment, claim 12 has been amended to correct a typographical error therein and not to address any prior art rejections. As discussed in detail above, claim 12 is believed to be allowable over the references asserted against it in the Official Action. Accordingly, claims 14 and 15 are also seen to be allowable over those references in their present unamended forms.

With respect to claims 23-27, those claims depend either directly or indirectly from claim 22. As was discussed above, claim 22 is seen to be patentable over the references asserted against it in the Official Action. Accordingly claims 23-27 are also seen to be allowable over those references in their present unamended forms.

Claim 31 depends from claim 30 which is seen to be allowable over the references cited against it. Accordingly claim 31 is also seen to be allowable over those references in its present form.

Claim 35 has been rewritten as new independent claim 50 and claim 36 has been rewritten as new claim 51. Claims 50 and 51 are in condition for allowance.

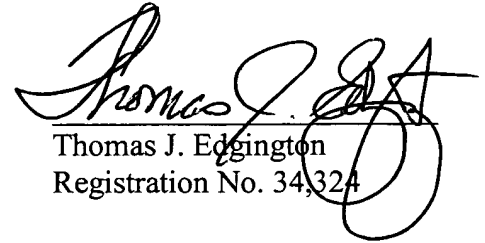
IV. Conclusion

Applicant submits that all of the pending claims are in condition for allowance. Accordingly, reconsideration and withdrawal of the rejections in the Official Action and passage to allowance of all the pending claims at an early date are earnestly solicited. However, if the Examiner has any remaining concerns regarding Applicant's present Amendment, she is invited

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to contact the Applicant's undersigned attorney at the telephone number listed below so that those concerns may be expeditiously addressed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Thomas J. Edgington", is written over a horizontal line. Below the line, the text "Thomas J. Edgington" and "Registration No. 34,324" is printed. The signature is stylized with a large, looping "T" and "E".

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